

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Giacomo Digrigoli et al.	Examiner:	Frantzy Poinvil
Serial No.:	10/608,525	Group Art Unit:	3696
Filed:	June 26, 2003	Docket:	2043.114US1
Customer No.:	49845	Confirmation No.:	9327
Title:	MULTICURRENCY EXCHANGES BETWEEN PARTICIPANTS OF A NETWORK-BASED TRANSACTION FACILITY		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for at least the reasons stated below.

In the *Advisory Action* dated September 8, 2009, the Examiner maintained his rejection of claims 1-37 under 35 U.S.C. § 103(a) as allegedly being obvious over Boesch et al. (U.S. Patent No. 5,897,621; *Boesch*). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.¹

“If any of these [three] findings cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious.”² Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants’ claimed elements, with no change in the respective functions of the cited references,

¹ See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

nor is there any substantiating evidence that the combination of the references would have yielded nothing more than predictable results.

Independent claim 1 recites, in part, “the user interface to enable a **receiving of a selection from the recipient**, the selection from the recipient is selected from a group consisting of an **acceptance of the payment** in the sender-selected currency and a **denial of the payment** in the sender selected currency.”³ In other words, the recipient of a payment (e.g., a merchant) may approve or deny payment in a sender-selected currency.

In contrast, *Boesch* clearly states “[i]t is **not required that the merchant user 303 know or approve the customer selected currency**, that is, the currency in which the customer user 203 will pay.” (emphasis added) *Boesch* at col. 7 lines 60-63. The Examiner points out that “in the preceding paragraph, *Boesch* states ‘In a further aspect of this embodiment, we prefer that along with providing the amount in the customer selected currency A (CSC), the customer computer 200 also transmit the agreed price in the merchant accepted currency P (MAC).’ *Final Office Action* at 2-3. However, this cited portion of *Boesch* is merely directed to providing exchanged currency information (in the merchant accepted currency) based on the customer selected currency. This portion in no way teaches an acceptance or denial selection from the recipient. “Approval of a currency would be, for example, where the customer user 203 would need the permission of the merchant user 303 to pay in a given customer selected currency.” *Boesch* at col. 8, lines 4-7. As such, *Boesch* clearly **teaches away** from this limitation of claim 1, and claim 1 is not obvious in view of *Boesch*.

The Examiner argued that “*Boesch* et al are directed to a commerce system in which a customer in a given type currency provides payment to a merchant for the purchase of goods and/or services. Both the customer and the merchant agree to the currency pair being used.” *Final Office Action (Office Action)* at 5 (citing to *Abstract of Boesch*). However, the *Abstract of Boesch* states that,

The customer computer includes a first set of data which contains an amount the customer is willing to pay. . . The merchant computer includes a second set of data which contains a product price at which the merchant agrees to sell. . . The server then converts the amount in the first currency [of the customer] into a converted amount in the

² MPEP § 2143, emphasis added.

³ Emphasis added.

second currency [of the merchant]. The server approves the transaction if the converted amount in the second currency is within a risk range of the product price in the second currency. (Emphasis added.)

The *Abstract* does not state or even infer that a customer and a merchant agree to the currency pair, but merely indicates that the customer computer provides an amount the customer is willing to pay and the merchant computer provides an amount at which the merchant is willing to sell. There is no agreement. In fact, it is the server that determines whether to approve the transaction based on whether a converted currency amount is within a risk range. Not only does the *Abstract* not support the Examiner's arguments, but the server approving the transaction provides yet another example of how *Boesch* teaches away from the limitations of claim 1.

The Examiner concluded that

[I]t would be have been obvious to one of ordinary skill in the art to note that at the time the invention was made that if the customer selects a currency not acceptable by the merchant, the merchant would have sent a notification to the customer informing the customer of an unacceptable selection of a currency by the customer. Therefore, denying acceptance of the sender selected currency and resulting in informing the recipient of a denial of the payment in the sender selected currency would have been done by either the merchant or the server of the system of Boesch et al.⁴

However, the purpose of *Boesch* is for a server to perform a currency conversion. Based on a converted currency being within a risk range, the server approves the transaction. "Once the transaction is approved, the approving entity [of the server] may settle the transaction at its discretion thereby bearing the risk associated with the currency exchange." *Abstract of Boesch*. This requires "that the server be able to convert one such currency into the other." *Boesch* at col. 7, lines 65-67. Thus, *Boesch* will always convert the customer's currency into the merchant's currency. As such, there will never be an occasion in *Boesch* for "a currency not acceptable by the merchant" or for the merchant to send "a notification to the customer informing the customer of an unacceptable selection of a currency by the customer" as the Examiner alleged in the *Office Action*.

In the Response to Arguments section of the *Office Action*, the Examiner argued that

⁴ *Office Action* at 5.

Boesch states ‘In a further aspect of this embodiment, we prefer that along with providing the amount in the customer selected currency A (CSC), the customer computer 200 also transmit the agreed price in the merchant accepted currency P(MAC) to the server 100. This assures that the customer user 203 and the merchant user 303 have actually reached agreement on the terms of the transaction and precludes either party from denying such agreement. Other information may be transmitted by the customer computer 200 as needed by the server, for example, a requested payment range (described later), information identifying the customer user 203, the product to be purchased, account information, etc.’ Thus from this teaching, it is clearly noted that Boesch teach the claimed function.⁵

However, the cited portion of *Boesch* refers to receiving various information from a customer or sender of the payment. *Boesch* does not contemplate enabling “a receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance of the payment in the sender-selected currency and a denial of the payment in the sender selected currency” as is recited by Applicants’ claimed element.

For at least the above reasons, Applicants assert that independent claim 1 is patentable over *Boesch*. Independent claims 24, 34, and 36 recite similar language with respect to a limitation of “receiving of a selection from the recipient, the selection from the recipient is selected from a group consisting of an acceptance of the payment in the sender-selected currency and a denial of the payment in the sender selected currency.” Therefore, claims 24, 34, and 36 are not obvious over *Boesch* for at least the same reasons as those provided for claim 1.

Independent claims 13, 31, 35, and 37 each recite a limitation directed to “receiving from the recipient via the communications network data indicating a recipient decision with respect to an acceptance of the payment in the sender-selected currency.” As discussed above with respect to claim 1, *Boesch* does not require that the recipient (e.g., merchant user) approve or accept the customer selected currency. This acceptance is not required because the invention of *Boesch* is directed to, and always requires, “that the server be able to convert one such currency into the other.” *Boesch* at col. 7, lines 65-67. Therefore, independent claims 13, 31, 35, and 37 are not obvious over *Boesch* because *Boesch* teaches away from at least one limitation of claims 13, 31, 35, and 37.

⁵ Office Action at 2-3.

Applicants respectfully disagree with the Examiner's rejection of claims 2-12, 14-23, 25-30, 32, 33, 38, and 39 for at least the reasons that these claims depend from otherwise allowable independent claims as discussed in detail herein. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. §112 ¶4. As such, Applicants assert that dependent claims 2-12, 14-23, 25-30, 32, 33, 38, and 39 are allowable for at least the same reasons as the independent claims from which they depend. Further, each of these dependent claims may contain additional patentable subject matter.

CONCLUSION

Applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the under-signed attorney at (408) 278-4040 to discuss any questions that may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 28 September 2009

By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28th day of September 2009.

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